



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,712	08/08/2001	Jeffrey John Jancula	13575.340	3981

21878 7590 12/05/2006

KENNEDY COVINGTON LOBDELL & HICKMAN, LLP
214 N. TRYON STREET
HEARST TOWER, 47TH FLOOR
CHARLOTTE, NC 28202

EXAMINER

NGUYEN, MINH DIEU T

ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 12/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924,712

Applicant(s)

JANCULA, JEFFREY JOHN

Examiner

Minh Dieu Nguyen

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-87 and 89-100 is/are pending in the application.
- 4a) Of the above claim(s) 88 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-26,28-33,36-42,44-54,56-59,61-69,71-79,81-87 and 89-100 is/are rejected.
- 7) ☒ Claim(s) 2, 24, 27, 34-35, 43, 55, 60, 70 and 80 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the communication dated September 26, 2006 with the amendments to claims 1, 17, 41, 63, 73 and 78, the cancellation of claim 88 and the addition of claims 91-100.

Claims 1-87 and 89-100 are pending.

Response to Arguments

2. Applicant's arguments filed September 26, 2006 have been fully considered but they are not persuasive. Applicant argues that Walker discloses a financial instrument (i.e. letter of credit ("LC")) as opposed to the document of the present invention and Walker does not teach communicating confidential information among at least three consenting parties in the same document. The applicant respectfully disagrees, Walker discloses a method and apparatus in which parties negotiate and sign a contract (i.e. document) (col. 5, lines 36-40). At least in Figures 1 and 2, Walker discloses several parties communicated in the contract negotiating and signing process as well as permission certificate distribution process. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., permits negotiation of some terms (namely, the expiration date) without altering the signed portions of the document (page 19 of the Remarks); establishes a new relationship among the parties in the same document (page 19 of the Remarks); allows each party to independently apply an expiration date

Art Unit: 2137

and immediately apply their signature to its completed portion of the document, without affecting portions signed by other parties (page 19 of the Remarks); permission certificate is not needed to authorize transactions (page 20 of the Remarks); databases is not required (page 22 of the Remarks) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The applicant argues that Walker teaches away from the present invention because Walker discloses the buyer, seller and trusted agent must have a pre-established banking relationship. The examiner respectfully disagrees, Walker discloses the conventional process with the requirement of pre-established banking relationship is difficult to do business (col. 3, lines 41-54), therefore there is no need for any prior relationship with the bank, buyer or seller (col. 10, lines 12-14). The applicant argues a single expiration date is agreed before signing, whereas in the present invention, a mutually acceptable expiration date is arrived at by applying multiple dates and signatures, however "adding an expiration time to said document in order to validate said document" is the cited claimed limitation and it is fully disclosed by Walker. The applicant argues that an account's expiration date is being optional based on Fig. 9, element 806. The examiner contends that the expiration time is included in the contract terms database (Fig. 8, element 804) and the contract terms database has the same structure as Fig. 6, element 504 (col. 8, lines 20-22) and the CEA expiration is the same as the contract's expiration date (col. 9, lines 61-65). Applicant argues that Walker does not teach encrypting the contract. As stated in the previous rejection,

Art Unit: 2137

Walker does not explicitly disclose encrypting the contract, however Walker discloses some or all data fields in a permission certificate are encrypted, the concept of encryption is well-known in data communication and can be applied to enhance data security of some or all data in the contract. The applicant argues that the contract in Walker does not contain information for three parties. Walker discloses contracts have two signatures (admitted by the applicant on page 20 of the Remarks), Walker discloses a method and apparatus for contract negotiation among transacting parties (i.e. multiple parties col. 7, lines 8-9), the fact that two signatures in the contract can be implemented to include more signature for more transacting parties as the contract is normally an agreement between two or more parties. Therefore the examiner believes Walker allows at least three parties to approve the document. In regard to paragraph 4(I) of the Office Action, the examiner agrees with the applicant's remark, however the examiner contends that Walker discloses expiration date in the contract as well as in the permission certificate and he further discloses anyone who presents the correct certificate (i.e. the valid, non-expired certificate) can operate on the account (col. 7, lines 12-15), it clearly anticipates the use of document for an unlimited number of times prior to expiration of the document.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

Art Unit: 2137

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-7, 13-17, 22-23, 25-26, 28-33, 36-38, 41-42, 44-48, 53-54, 56-59, 61-63, 68-69, 71-73, 78-79, 81-84, 91-93 and 96-100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (6,477,513).

a) As to claims 1, 41, 78, 91 and 99, Walker discloses a method and system for executing electronic transactions comprising establishing a relationship among the parties (col. 2, lines 20-37); creating a document initiated by one of the parties (col. 5, lines 42-43); adding verifying information to the document about each of the parties to the document in order to validate the document (col. 5, lines 42-49); adding an expiration time to the document in order to validate the document (Fig. 6, element 612); at least one of the parties presenting the document to at least one other of the parties prior to communication of the confidential information therebetween (col. 9, lines 55-56) and the other of the parties permitting the communication of the confidential information (i.e. granting permission certificate) therebetween only if the document is valid and the expiration time has not passed (col. 10, lines 18-20). Walker does not explicitly disclose permitting the communication of the confidential information if expiration time has not passed, however there is a direct relationship between a contract, a cryptographically-enabled account (CEA) and account terms and conditions (ATAC) (col. 9, lines 58-65), ATAC includes the expiration date of the contract, further Walker discloses a CEA has a finite lifetime dictated by the ATAC, before the expiration date of the account, a permission certificate needs to be enabled to the seller (col. 11, lines 40-64). This

Art Unit: 2137

anticipates permitting the communication of the confidential information if expiration time has not passed.

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of permitting the communication of the confidential information if expiration time has not passed so as to confirm the validity of the document.

b) As to claims 3, 44 and 96, Walker discloses a portion of permission certificate is encrypted (col. 7, lines 58-59), the encryption concept can be implemented on a portion of the contract so as to enhance security of certain data in the contract.

c) As to claims 4, 14, 28, 36, 45, 56, 61, 71, 81 and 97, Walker discloses at least a portion of the document is symmetrically encrypted (col. 9, lines 5-10).

d) As to claims 5, 15, 29, 37, 46, 57, 62, 72, 82 and 98, Walker discloses at least a portion of the document is asymmetrically encrypted (col. 9, lines 5-10).

e) As to claims 6, 16, 22, 47, 83 and 99, Walker discloses the document includes a digital signature of each of the parties (col. 9, lines 12-33).

f) As to claims 7 and 17, 38, 48, 63, 73, 84 and 100, Walker discloses the encrypted information (i.e. encrypted permission certificate) is capable of decryption using an encryption key (Fig. 18) (also see addressed claim 3).

g) As to claims 13, 25, 53, 58 and 68, Walker discloses a method and system for executing electronic transactions comprising establishing an electronic communication relationship among all the parties (col. 2, lines 20-37); creating an electronic ticket initiated by a first of the parties (col. 5, lines 42-43); adding security

information pertaining to the first party to the electronic ticket (Fig. 12, element 1214) and then sending the electronic ticket to a second of the parties (Fig. 13, element 1302); adding security information pertaining to the second party to the electronic ticket (Fig. 13, element 1304) and then sending the electronic ticket to a third of the parties (Fig. 13, element 1306); validating the electronic ticket by verifying the security information pertaining to the at least three parties; at least one of the parties presenting the electronic ticket to another of the parties prior to communicating confidential information therebetween (col. 9, lines 55-56) and the other of the parties permitting the communication of confidential information (i.e. granting permission certificate) therebetween only after the electronic ticket is validated (col. 10, lines 18-20).

Walker does not explicitly disclose validating the electronic ticket by verifying the security information pertaining to the at least three parties, however Walker discloses using digital signature in the contract to prevent buyer or seller from altering or repudiating the contract (col. 6, lines 51-53) and practicing digital signature to ensure the authenticity of senders as well as the integrity of communications (col. 9, lines 16-18). This anticipates validating the electronic ticket by verifying the security information pertaining to the at least three parties.

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of security information (digital signature) pertaining to at least three parties and verifying them to validate the electronic ticket so as to confirm the validity of the contract (i.e. electronic ticket).

Art Unit: 2137

h) As to claims 23, 26, 32, 42, 54, 59, 69 and 79, this limitation is addressed in claim 1.

i) As to claim 30, Walker discloses a method and system for executing electronic transactions comprising requiring the security document to be presented to the first party by one of the second and third parties prior to permitting the communication of confidential information (col. 9, lines 55-56); permitting the communication of confidential information (i.e. granting permission certificate) of the second party with the third party only after verifying that the security document is valid (col. 10, lines 18-20).

Walker does not explicitly disclose adding encrypted security information pertaining to the first party to a security document, however Walker discloses the security information pertaining to each of the parties (col. 5, lines 42-49). Walker also discloses several cryptographic protocols such as encryption functions, hash functions can be used to ensure the authenticity of senders as well as the integrity of communications (col. 9, lines 5-23).

It would have been obvious to one of ordinary skill in the art at the time of the invention to implement adding encrypted security information pertaining to the first party to the security document so as to securely protect transmitted data.

j) As to claims 31 and 33, Walker discloses the invention relates to electronic transactions which automatically performs services among parties (Abstract), it anticipates the security document is an electronic document, the encrypted security

information being added electronically, the confidential information being communicated electronically and the expiration time is added electronically.

k) As to claim 92, Walker discloses the electronic document is stored by at least one party (Fig. 6).

l) As to claim 93, Walker discloses the third party has use of the electronic document for an unlimited number of times prior to expiration of the electronic document (col. 3, line 20 – col. 4, line 19).

5. Claims 10-11, 20-21, 51-52, 66-67, 76-77, 87 and 89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (6,477,513) in view of Schneier (Applied Cryptography).

Walker does not disclose the private key is a multiple use key or a one-time use key.

Schneier discloses the lifetime of a key wherein some key can be used one time and other key could be used multiple times over a period of time (page 183-184).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of determining the permitted lifetime of a key as Schneier teaches in the system of Walker so as to reduce number of attacks.

6. Claims 8-9, 12, 18-19, 39-40, 49-50, 64-65, 74-75, 85-86 and 90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (6,477,513) in view of Stallings (Cryptography and Network Security).

Art Unit: 2137

a) As to claims 8-9, 18-19, 39-40, 49-50, 64-65, 74-75 and 85-86, Walker discloses public key encryption (col. 9, lines 5-12). However he does not disclose the encryption key is a public key or a private key.

Stallings discloses encryption key is a public key or a private key (page 165-166).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of public key or private key as encryption key in the system of Walker as Stallings teaches so as to securely protect communicated data.

b) As to claims 12 and 90, Stallings discloses the encrypted information is encrypted with a public key and capable of decryption using a private key (Fig. 6.1 on page 166).

7. Claims 94 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al. (6,477,513) in view of McKenney et al. (2006/0004670).

Walker does not explicitly disclose the electronic document further comprises a serial number and the serial number is used for auditing or tracking purposes.

McKenney discloses electronic document comprising a serial number and the serial number is used for auditing or tracking purposes (i.e. transaction reference, table 27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of electronic document comprising a serial number and the serial number is used for auditing or tracking purposes in the system of Walker as McKenney discloses so as to easily monitor electronic document.

Allowable Subject Matter

8. Claims 2, 24, 27, 34-35, 43, 55, 60, 70 and 80 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

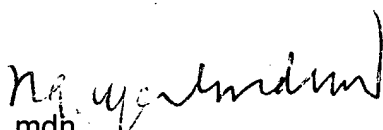
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh Dieu Nguyen whose telephone number is 571-272-3873.

Art Unit: 2137

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on 571-272-3865. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


mdh
11/28/06


EMMANUEL L. MOISE
SUPERVISORY PATENT EXAMINER